



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/702,407 Confirmation No. 8333
Applicant(s) : Richard L. Ornberg, *et al.*
Filed : November 5, 2003
TC/A.U. : 3738
Examiner : David J. Isabella
Docket No. : 26775-501
Customer No. : 35437
For : **BIOPOLYMERS MODIFIED WITH SUPEROXIDE DISMUTASE
MIMICS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT UNDER 35 U.S.C. § 121

This communication is filed in response to the Restriction Requirement dated July 8, 2004 which was issued in connection with the above-identified application. A petition to extend the due date for responding to the Restriction Requirement to September 8, 2004 and the fee required under 37 C.F.R. § 1.17(a)(1) accompanies this response.

In response to the Restriction Requirement, applicants elect with traverse to prosecute the claims of Group I, claims 1-6, 11, 12, 13, and 14 directed to the biopolymer. Applicants further elect for preliminary examination purposes only the species of claim 13 (referred to in the Restriction Requirement as "figure 13"), with no-side branch. Applicants make this species election for examination purposes only and reserve the right to have all species examined on the merits in the subject application.

Applicants respectfully traverse the restriction requirement. Applicants maintain that it has not been demonstrated that the claims as grouped represent independent and distinct inventions as required under 35 U.S.C 121. M.P.E.P. 808.01 defines "independent inventions" as those having no connection in design, operation or effect. Because the compounds defined in the claims all have a related core structure, the claims are connected and therefore not "independent" and applicants should be allowed to have all claims examined on their merits.

Applicants also maintain that the restriction requirement is improper because the Examiner did

not demonstrate that the search of the separate claims presents an undue burden on the Examiner. Because the Examiner has not demonstrated the "various" classifications under which these claims allegedly fall, Applicants respectfully maintain that it has not been established that a search for the general structure would not retrieve references pertinent to all of the groups of claims. For the reasons discussed above, Applicants maintain that the search of art for any of the groups of claims would necessarily cover art for all of the various groups of claims.

Moreover, applicants maintain in particular that the claims of Group IV should be grouped together with the elected claims of Group I since, by not listing a separate class and subclass for these claims, the restriction requirement does not support the conclusion that a search for art related to the claims in Group I would not also reveal art related to the claims of Group IV. Thus, applicants respectfully request that, at the very least, the restriction between groups I and IV be removed.

Favorable action on the merits is respectfully requested. If there are any questions regarding this Response, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Applicants believe that no additional fees are due with the filing of this Response. However, if any additional fees are required or if any funds are due, the USPTO is authorized to charge or credit Deposit Account Number: 50-0311, Customer Number: 35437, Reference Number: 26775-501.

Respectfully submitted,



Richard Gervase, Reg. No. 46,725
Matthew J. Golden, Reg. No. 35,161
Attorney/Agent for Applicant
c/o MINTZ, LEVIN
666 Third Avenue – 24th Floor
New York, New York 10017
Telephone: (212) 935-3000
Telefax: (212) 983-3115

Date: September 8, 2004